

Appln. No.: 10/092,209  
Response/Amendment dated March 7, 2006  
Response to Non-Final Office Action dated September 7, 2005

### **REMARKS/ARGUMENTS**

Claims 1-5, 8, 10-14, 16-21, 23-26 and 34-41 are pending in the application. Claims 1-5, 8, 10-14, 16-21, 23-26 and 34-41 are rejected. Through this Amendment, claims 1 - 2, 18 - 19, and 35 have been amended. New claims 42 - 46 have been added. No new matter has been introduced into the application. As explained in more detail below, Applicants submit that all claims are in condition for allowance and respectfully request such action.

#### **Claim Objections**

Claims 1 - 2, 18 - 19, and 24 are objected to due to informalities outlined in page 2 of the amended suggestions by the Examiner to overcome the prior art, however, the scope of the claims have not been changed. Claim 24 has not been amended since the limitation of "receive a selection of lottery games" is not the same "selection" recited in independent claim 18 from which claim 24 depends. Therefore, this is the first instance of "selection of lottery games" being recited in the chain of related claims, therefore the Applicants believe the term "a" to be appropriate instead of "said". Claim 35 is objected to as being substantially a duplicate claim of 34. Through this Response and Amendment, the Applicants have amended claim 35 to properly depend from independent claim 18. In view of the foregoing, the Applicant respectfully request withdrawal of the objections.

Appln. No.: 10/092,209  
Response/Amendment dated March 7, 2006  
Response to Non-Final Office Action dated September 7, 2005

**Claim Rejections – 35 USC § 103**

Claims 1-5, 8, 10-14, 16-21, 23-26 and 34-41 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pat. No. 5,816,919 to *Scagnelli et. al*, ("the '919 patent") in view of U.S. Pat. No. 6,149,156 to *Feola*, ("the '156 patent"). The Applicants traverse the rejection in view of the Remarks below.

The Office Action alleges the '919 patent discloses a method of providing electronic lottery games over a wireless network from an electronic betting service to a wireless game terminal having a display and a button array. The Office Action further asserts that while the '919 patent does not disclose a presenting a plurality of objects on the display to allow the player to elect on of the objects, it would have been obvious to use the cellular phone disclosed in the '156 patent to present a plurality of objects on the display to allow a player to select an object. The Applicants respectfully disagree as there is no motivation to combine the references and, even upon combining the '919 patent with the '156 patent, the subject matter of the rejected claims is not taught or otherwise suggested.

First, it would not have been obvious to one skilled in the art to combine the audio wagering system of the '919 patent with the card game of the '156 patent. As provided in the Summary of the Invention of the '919 patent, the invention provides "an automatic call director means (ACD) for receiving incoming enrollment calls from subscribers...a first voice responsive means (enrollment VRU)...for playing a series of recorded audio messages...a second voice responsive means (wagering VRU)...for playing a series of recorded audio messages...and a host processor means." Col. 2, lines 1 – 42. Indeed, each embodiment of the '919 patent relates

Appl. No.: 10/092,209  
Response/Amendment dated March 7, 2006  
Response to Non-Final Office Action dated September 7, 2005

to a user calling a telephone number and listening to audio messages before choosing to place a wager on a specific event or game.

Along these lines, one skilled in the art would not be motivated to combine a card game, output, rather the '919 patent is merely directed to voice recognition system. ~~because there is no~~ In the '156 patent with the system of the '919 patent, there is no wager. Indeed, applying the game of the '156 patent with the voice recognition systems of the '919 patent would only produce a cellular phone capable of sending voice signals to the voice recognition means. The combination would not produce the subject matter of the rejected claims, for example, at least the step of allowing a player to elect one of said objects by activating a button of said button array. Along these lines, the Office Action is silent as to where a mobile terminal is shown in the references that could produce the graphical objects of gameplay.

The Applicants further disagree with the Office Action's interpretation of the '919 patent. More specifically, the Office Action believes the step of transmitting a game identification number over a wireless network from a betting service to said wireless game terminal is taught in Col. 6, lines 45-53 and Figs. 3B and 3C of the '919 patent. The cited portion of the '919 patent discusses a game selection script where a voice recognition unit "presents the subscriber with the various lottery games available with the selected lottery." Col. 6, lines 46 - 7; emphasis added. The "selected lottery" is the state-run lottery selected in the previous step. See Col. 6, lines 40 - 44. Indeed, the '919 patent makes it clear that "different state lotteries have variations on the range of number[s] which can be selected." Col. 7, lines 46 - 7. Therefore the cited portion of

Appl. No.: 10/092,209  
Response/Amendment dated March 7, 2006  
Response to Non-Final Office Action dated September 7, 2005

the '919 merely discloses a voice recognition means for receiving a wager for a lottery or game that is conducted by a third party at a later time.

In contrast, the rejected claims recite a game identification number for each game. As provided in the Specification, "[e]ach game ticket has a lottery ID number associated with it that identifies it to the betting service. The lottery ID number is transmitted to the user along with the parameters of the game... Once received by the user, the game ticket can be played on a wireless station." Specification, page 5, lines 22 – 25. As explained in reference to one embodiment of gameplay:

"Once the button is selected, the wireless station transmits the lottery ID number and the selected button to the betting service provider 210. The betting service provider 210 matches the button selected for the lottery ID number to a value. The value, which may be a dollar amount or even a "WIN" or "NO WIN" display, is chosen and communicated back to the wireless station 202.

Specification, page 8, lines 14 – 19; emphasis added. As stated above, the cited text of the '919 patent discloses a lottery game that is conducted by a third party that will be conducted in the future. Moreover, the lottery will not be conducted at an individual mobile terminal.

The Office Action also alleges that the limitations of calculating win/loss value at the betting service and transmitting the win/loss value to the game terminal is somehow met by a boilerplate paragraph found just preceding the claims in the '919 patent states the voice recognition systems may be applied to "instant" games which provide an immediate indication of the a winning selection. The entire preceding disclosure only discusses the wagering of bets with third-party lotteries without disclosing mechanisms or methods for conducting the lotteries, which is also not provided in the cited paragraph. In fact, the cited text does not enlighten one skilled in the art on what the rules of the game are, how the game is transmitted (nor does it even suggest a mobile terminal capable of having displayed objects or having such a game played on

Appl. No.: 10/092,209  
Response/Amendment dated March 7, 2006  
Response to Non-Final Office Action dated September 7, 2005

it). In contrast, as recited in the rejected claims, these limitations are performed by a plurality of game parameters associated with said game identification number from said wireless network. See, e.g. Claims 1, 10, 18. As discussed in detail above, the '919 patent does not disclose, teach, or otherwise suggest the game identification number as claimed, never mind such a number associated a plurality of game parameters. Therefore, one skilled in the art would not be enabled to practice anything remotely similar to the rejected claims by the mere reference to providing an immediate indication of winning selections through a voice recognition system.

For at least the reasons outlined above, neither the '919 nor the '156 patent, individually or in combination teaches, discloses, or suggests the subject matter of the rejected claims. The Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection and allowance of the rejected claims.

#### New Claims

New independent claim 42 recites a wireless user terminal configured to receive the lottery-type games discussed throughout the Specification. Likewise, new independent claim 43 recites a betting system server configured to transmit the lottery-type games discussed throughout the Specification. Dependent claims 44 – 46 recite steps for linking the game identification number to the user of the wireless game terminal who purchased the game and comparing the game identification number to the user playing the game to verify if the user playing the game is the same user that purchased the game. (See, e.g., Specification, Page 7, lines 18 – 25) No new matter has been added. Since no art of record teaches, discloses, or otherwise suggests the subject matter of the newly added claims the Applicants respectfully

Appln. No.: 10/092,209  
Response/Amendment dated March 7, 2006  
Response to Non-Final Office Action dated September 7, 2005

**CONCLUSION**

The Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,

**BANNER & WITCOFF, LTD.**

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By: 

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